

## **REMARKS**

In response to the Office Action mailed December 2, 2004, Applicants make the following remarks. Claims 1, 2, 4, 6, and 7 have been amended to more clearly define the subject matter of the invention. Claim 3 has been canceled and claim 8-11 have been added. The specification and the abstract have been amended to correct typographical errors and more clearly define the subject matter of the invention. Claims 1, 2, and 4-11 are presently pending.

Claims 1-7 stand objected to because of informalities. Claims 1 and 6 have been amended, Applicants submit that the claims fully satisfy the statute, and request that the objection be withdrawn.

Claims 1, 3, and 5-7 stand rejected as anticipated by U.S. Patent No. 5,879,178 to Koumatsu et al. under 35 U.S.C. § 102(b). Applicants respectfully traverse this rejection. Claim 1, as amended, recites a packing comprising a solid-core ring-shaped packing body having a thickness in a first direction in which the first article and the second article face each other larger than a width in a second direction orthogonal to the first direction. A protruding piece protrudes outwardly from an outer edge of the solid-core ring-shaped packing body at a midpoint along the thickness of the packing body. A securing portion is attached to the protruding piece and secured to the first article. The securing portion extends from the protruding piece so that the protruding piece provides a restoring force preventing the packing body from falling or rolling to one side when first and second articles are mated.

Koumatsu et al. does not disclose a packing having all of the claimed features. For example, Koumatsu et al. does not disclose any packing that includes, among other things, a securing portion (see Examiner's attached figure) extending from a protruding

piece (referred to by the Examiner as 4a) so that the protruding piece provides a restoring force preventing the packing body from falling or rolling to one side when first and second articles are mated. The element of Koumatsu et al. designated by the Examiner as corresponding to the claimed securing portion does not extend from the protruding piece so that the protruding piece prevents the packing body from falling or rolling to one side when first and second articles are mated.

Thus, the Examiner has not demonstrated that the claims are anticipated and the rejection should be withdrawn. Claims 2 and 4-7 depend directly or indirectly from claim 1 and therefore are allowable for at least the same reasons.

Claims 1, 2, and 4 stand rejected as unpatentable over U.S. Patent No. 2,903,626 to Nye et al. under 35 U.S.C. § 103(a). Applicants respectfully traverse this rejection.

Nye et al. does not disclose any packing having the claimed features, including, for example, a securing portion (referred to by the Examiner as the holes in gasket 44) extending from a protruding piece so that the protruding piece provides a restoring force preventing the packing body from falling or rolling to one side when first and second articles are mated. The holes in the gasket of Nye et al. do not "extend from" any protruding piece of the gasket. Because Nye et al. does not disclose each and every limitation of the claim, the Examiner has not established a prima facie case of obviousness and the rejection should be withdrawn.

The Examiner asserts that a change in the size of the width or thickness of the packing is "a function of the size that is dependent upon the parameters that the customer desires." The Examiner cites *In re Rose* to support his assertions. However,

claim 1 recites that the thickness of the packing body in a first direction is larger than a width of the packing body in a second direction orthogonal to the first direction. This claim limitation is not "a mere change in size," but represents a change in relative dimensions of the packing body. Such relative dimensions affect the packing body's performance and are not based merely on customer desire. Such relative dimensions, for example, allow downsizing of the packing body while maintaining its performance.

For the reasons expressed above, new claims 8-11 are patentable over the prior art of record.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By: \_\_\_\_\_

  
Jill DeMello  
Reg. No. 42,477